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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,949	01/22/2001	Daniel B. Workman	1958.2009-000	3380
58403 7590 07/16/2007 BARRY W. CHAPIN, ESQ. CHAPIN INTELLECTUAL PROPERTY LAW, LLC WESTBOROUGH OFFICE PARK 1700 WEST PARK DRIVE WESTBOROUGH, MA 01581			EXAMINER BASEHOAR, ADAM L	
			ART UNIT 2178	PAPER NUMBER
			MAIL DATE 07/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/766,949	Applicant(s) WORKMAN ET AL.	
	Examiner Adam L. Basehoar	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-31 and 41-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-31, and 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: The Amendment filed 04/12/07.
2. Claims 1-13, 15-31, and 41-50 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman et al (5,909,678 06/01/99) in view of Horowitz et al (US-6,122,647 09-2000).
3. Claims 1-13, 15-31, and 41-50 are pending in the case. Claims 1, 11, 13, and 41 are independent claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13, 15-31, and 41-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman et al (5,909,678 06/01/99) in view of Horowitz et al (US-6,122,647 09-2000).

-In regard to independent claims 1, 11, 13, and 41 Bergman et al teach a method, system, and product for editing a form, wherein;

a user was displayed an interface (Fig. 9: 911) displaying a hyperlink (phrase receptacle) for an element in the form (column 3, lines 17-18) (Fig. 4: 200) indicating to a user that a control is available for the element (column 3, lines 6-28, 46-49, 57-67; column 4, lines 1-9), said hyperlink providing one of a group consisting of a link from the form to another location and a

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link from the form to another file (column 7, lines 31-44: i.e. selecting a given phrase receptacle enforces semantic constraints that link to the appropriate phrase and objects in the different menu boxes); wherein

upon selection of the hyperlink of the element, the control displayed on the user interface for user interaction (Fig. 3: Selection of element 200 displays control 11 for user interaction); and wherein

upon completion of user interaction with the control, replacing the element with a new element responsive to user (Fig. 2: Select element 210 and Fig 3: Replace element with new element 210 selected from control 11).

Bergman et al do not teach wherein the hyperlink linking between the phrase template and the menu boxes contained a URL. Horowitz et al teach wherein a query target had more than one target, creating a dynamic menu containing a plurality of possible links at the link anchor, wherein the hyperlink to the menu contained a URL (column 10, lines 28-67; column 11, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time of the invention for the phrase receptacles to have contained a URL to link to the different menu boxes, because Horowitz et al teach that by utilizing a URL to a dynamic menu, a user could select a query item from all relevant values (column 10, lines 22-67; column 11, lines 1-2). It also would have been obvious to one of ordinary skill in the art at the time of the invention for the link between the phrase receptacles and the menu boxes to have been a hyperlink containing a URL, because it was notoriously well known in the art at the time of the invention that URL's were utilized to access information from across the World Wide Web, and thus Bergman et al would

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have been provided the obvious benefit of being able to access data to be inserted in to the phrase receptacles from a plurality of different locations outside the user computer (Fig. 9).

-In regard to dependent claims 2-3, 15-16, 23-24, and 42-43, Bergman et al teach wherein the form was a database query (column 5, lines 27-36) or spreadsheet (equivalent to a database) (column 5, lines 22-26).

-In regard to dependent claims 4-5, 17-18, 25-26, and 44-45, Bergman et al teach wherein the element was part of a formula or calculation (column 3, lines 9-10)(column 14, lines 25-30).

-In regard to dependent claims 6-7, 19-20, 27-28, and 46-47, Bergman et al teach wherein the control was a list of choices or a pull-down menu (column 8, lines 5-8)(Fig. 3&4).

-In regard to dependent claims 8-9, 21-22, 29-30, and 48-49, Bergman et al wherein the control was a dialog box or text entry field (column 8, lines 6-8).

-In regard to dependent claims 10, 12, 31, and 50, Bergman et al further teach wherein the control was selected from a group of controls consisting of a list (Fig. 3), a dialog box, and a text entry field (column 8, lines 5-8).

Response to Arguments

6. Applicant's arguments filed 04/12/07 have been fully considered but they are not persuasive.

-In regard to independent claims 1, Applicant argues that Bergman et al fails to teach or suggest hyperlinking or linking to a link target. As previously discussed, the Examiner does not agree with the Applicant's arguments with regards to this feature. Bergman et al clearly teaches wherein a user may select a phrase receptacle via clicking the receptacle which then links, via established semantic constraints, said receptacle to the appropriate phrase and objects in the different menu boxes, where acceptable objects are highlighted for user consideration (column 7, lines 39-44). In this case the phrase receptacles represent elements in an electronic document (i.e. the displayed phrase templates that contain them)(Fig. 3: 200) that when selected link to another place (i.e. the acceptable phrase objects)(Fig. 3: e.g. 113-120) in another document (i.e. the entity object menu)(Fig. 3: 11). Independent claim 1 only requires that the hyperlink, when selected, either link the form to another location or to another file. In Bergman et al, selecting the hyperlink phrase receptacle links the form phrase template to the menu box. The menu box is presented to the user for user interaction by highlighting the acceptable items that can then be dragged and dropped into the selected phrase receptacle. The Examiner notes that the term "link target" has not been utilized in the limitations of independent claim 1, and has been given no patentable weight. In fact the method claimed in Bergman et al is an exact example, minus the current disagreement on the term hyperlink, as disclosed in the Applicant's specification (Page 1, Lines 17-18; Page 2, lines 1-2: "clicking on the hyperlink can display an appropriate control...list of valid choices").

The Examiner also disagrees with the Applicant that Bergman et al reference teaches that the phrase receptacles must be empty and that because independent claim 1 does not require said supposed limitation that this strengthens the Applicant's arguments. While Bergman et al does teach that clicking an empty phrase receptacle highlights the acceptable items in the menu boxes, Bergman et al is silent on specifying that this must be the case. In view of the Bergman et al specification it would clearly have been within the scope of the invention to select a non-empty receptacle so that a user could determine a different acceptable term from the menu box without having to drag and drop out the previously selected menu box item.

The Examiner agrees that the term "hyperlink" does not appear in the Bergman et al reference. However the Examiner notes that the exact term need not be listed to meet the limitations of the claim, as long as all the claimed limitations/features of the term "hyperlink" are present in Bergman et al in the identical or similar context.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bergman et al teaches selecting an item and linking to a different menu box to select an appropriate item from said menu box. Bergman et al do not teach wherein the hyperlink linking between the phrase template and the menu boxes contained a URL. Horowitz et al teach wherein a query target had more than one target, creating a dynamic menu containing a plurality

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of possible links at the link anchor, wherein the hyperlink to the menu contained a URL (column 10, lines 28-67; column 11, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time of the invention for the phrase receptacles to have contained a URL to link to the different menu boxes, because Horowitz et al teach that by utilizing a URL to a dynamic menu, a user could select a query item from all relevant values (column 10, lines 22-67; column 11, lines 1-2). Applicant's main argument to the motivation appears to deal with statements pertaining to what was notoriously well known in the art at the time of the invention with regards to hyperlink URLs. The Examiner disagrees with the Applicant's reasoning and notes that because a reference does not explicitly teach a certain feature, that reference is not therefore precluded from having utilized said feature in view of what one of ordinary skill in the art would have known. Hence the reason for the 103(a) rejection. Applying this sort of logic, the Examiner notes that not even the present application would appreciate utilizing URLs because the term "URL" is not included in the specification and surely a large computer based corporation, and thus quite aware of URLs, wouldn't fail to mention URLs in their patent application.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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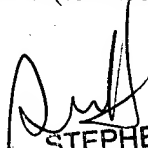
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB


STEPHEN HONG
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